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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,919	10/31/2003	John Walker	P2099	2997
30143	7590	06/17/2005	EXAMINER	
TODD N. HATHAWAY 119 N. COMMERCIAL ST. #620 BELLINGHAM, WA 98225			PATTERSON, MARIE D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/698,919

Applicant(s)

WALKER, JOHN

Examiner

Marie Patterson

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Sacre (4776109).

Sacre shows an insert comprising a one piece plastic body (24) with a raised medial arch (at 32) with a cut out below with a plurality of vertical ribs (40) therein with shapes and thicknesses as claimed (as shown in figures 2 and 4).

3. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lin (4619056).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (5722186) in view of Lin or Sacre.

Brown shows an insert comprising a non-compliant body (100) with a raised arch (at 110) and a bottom ridge (112) substantially as claimed except for ribs located under the raised arch portion. Either Lin or Sacre teaches providing ribs (20 or 40) beneath a

raised arch portion of an insert. It would have been obvious to provide ribs as taught by either Lin or Sacre in the arch portion of the insert of Brown to increase support and ventilation.

Response to Arguments

6. Applicant's arguments filed 5/6/05 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the thickness of the upper layer in the arch area, it is noted that the claims actually merely claim "a thickness in the arch portion that is generally similar to a thickness of said material in other areas of said body". This phrase does not require uniform thickness of the upper layer or really any specific relation of the thickness. Both Sacre and Lin show an arch portion that has a thickness which is exactly the same as the thickness in at least one other area of the body (as shown in their drawings), even though the claim does not require equal thickness to any portion, the claim only requires that the thickness is "generally similar" (which is an extremely broad and non-limiting phrase). In response to Applicant's argument that Sacre and Lin do not include certain features of Applicant's invention, the limitations on which the Applicant relies (i.e., the thickness of the upper layer being uniform thickness) are not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable.

Constant v. Advanced Micro-Devices Inc., 7 USPQ2d 1064.

In reference to applicants' arguments directed towards the functioning of the ribs, the ribs of Lin and Sacre do provide the function of support in the arch area and prevent the

upper layer from collapsing and changing shape to some extent. It is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. In re Swinehart, 169 USPQ 226 (CCPA1971). In response to applicants' argument that the ribs of Sacre "cause" the upper layer to collapse and change shape, this is not true. Sacre specifically states that the ribs "space the bottom surface of the sole member 24 above the supporting sole of the shoe whereby air can circulate" (column 2 lines 50-57). The flexing and pumping action argued by applicant is not caused by the ribs in Sacre it is caused by the "pump portion" (element 30) which is located below the heel of the wearer (see column 2 lines 62- column 3 line 4 and shown in figure 3 as clearly not part of the arch area or the ribs). In reference to the arguments directed towards Lin, the ribs/ridges of Lin do prevent the upper layer of material from collapsing (i.e. the ribs prevent the upper layer from contacting the sole layer as is inherent by merely being present) and prevent changing shape (i.e. arch area will remain raised in reference to other areas and thereby the overall shape of the compressed insert would remain the same and thereby supporting the arch in the compressed form the same as in the non compressed form and therefore the shape is considered to be the unchanged). Absent any further explicit structural limitations the

functional phrases are considered to be inherent in the structures which are the same as those which are explicitly claimed.

In response to applicants' arguments directed towards the 103 rejections, it is noted that by merely adding ribs below the raised arch of Brown would inherently prevent the upper layer of material from collapsing and changing shape to some extent merely by the present of additional material below the arch area.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306

Art Unit: 3728

(FORMAL FAXES ONLY). Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.

A handwritten signature in black ink, appearing to read 'Marie Patterson', with a stylized, cursive script.

Marie Patterson
Primary Examiner
Art Unit 3728